

REMARKS

I. Status of the Claims

Further to the foregoing amendments, claims 1-4, 6-23 and 27-72 are currently pending in this application. Claims 53-72 were withdrawn by the Examiner as being directed to non-elected subject matter as set forth in the restriction requirement dated July 15, 2005.

In the amendments, claims 24-26 were canceled, claim 1 was amended to include the limitations of claims 25 and 27, and claim 27 was amended to additionally recite graphite. Support for the amendments to the claims can be found in the originally filed claims and specification including, for example, paragraphs [067], [071], and [083] or the specification, and originally filed claims 25 and 27. Accordingly, no new matter has been added by this amendment.

II. Rejection under 35 U.S.C. § 103(a)

The Examiner maintained the rejection of claims 1-4 and 6-52 under 35 U.S.C. § 103(a) as being unpatentable over PCT Patent Publication WO 97/35457 ("*Tungare*") for the reasons disclosed on pages 3-4 of the final Office Action dated May 19, 2006. The Examiner issued an Advisory Action on November 29, 2006, stating that the rejection would be maintained because "applicants' arguments are drawn to the size of the particles wherein changes in size ordinarily are not a matter of invention." Applicants respectfully traverse this rejection for at least the reasons of record as well as for the following reasons.

The Examiner has the initial burden of presenting a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir.

1988). To meet this burden, the Examiner must demonstrate that the prior art reference teaches all the present claim limitations, and that there would have been some suggestion or motivation, either in the cited reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference teachings with a reasonable expectation of success. See M.P.E.P. § 2143.

Applicants respectfully submit that the rejection under §103 is fatally flawed at least because *Tungare* does not teach or suggest all of the claim elements, nor does it provide any motivation for its modification. As argued previously, *Tungare* does not provide motivation to select a particle size and/or an amount of particle that is effective to reduce tackiness of the glass fiber product. Further, nothing in *Tungare* teaches or suggests an average dimension ranging from 10 nm to 10 µm.

Nevertheless, in order to further distinguish the invention recited in independent claim 1 from the prior art, claim 1 has been amended to recite specific inorganic particles. *Tungare* does not teach or suggest the particles recited in claim 1 as presently amended. Instead, *Tungare* merely discloses various talcs and clays as the particle, and such particles are outside the scope of the presently claimed particles. Nothing in *Tungare* suggests to modify the type of particle disclosed therein in an attempt to arrive at the invention recited in amended claim 1. Therefore, absent clear and particular evidence of a motivation or desirability to modify *Tungare* to use the claimed particles, a *prima facie* case of obviousness has not been and cannot be established.

CONCLUSION

In view of the foregoing amendment and remarks, Applicants respectfully request reconsideration of this application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response, and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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